

REMARKS

Applicants gratefully acknowledge the courtesies extended by Examiner Vo in granting an interview to the undersigned and Jean-François Courtoy, one of the inventors, at the Examiner's office on July 20, 2004.

The foregoing amendments are made to clarify the claims and make the claim language more consistent. Some of the amendments also are made in response to the Examiner's rejections and objections in the Office Action mailed April 23, 2004 as discussed below.

Claims 31 and 35 have been amended to make it clear that the portion of the cured coating or the cured layer that is not disposed over the first ink is not mechanically embossed with said first mechanically embossed texture. The basis for this amendment appears in the specification at paragraphs [0005] and [0015] and elsewhere. Following the interview, applicants noted that the term "smoothed over" in amended claims 31 and 35 referred only to the mechanical embossing and not any optional chemical embossing that may be present in the same portion. Applicants accordingly have clarified the language to make it clear that the term "smoothed over" refers only to the mechanical embossing. Applicants respectfully request the Examiner's approval of this amendment.

Claims 33, 50 and 52 have been rewritten in independent form as suggested by the Examiner.

### Rejections under 35 U.S.C. §103

Claims 31, 32, 35, 46, 48 and 49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Courtoy, et al. (Re 33,599) in view of Baskin (U.S. 4,877,656). In the making the rejection, the Examiner acknowledges that Courtoy does not specifically disclose the mechanically embossed texture having relatively deep embossed depths as compared with a matting grain. However, the Examiner cites Baskin as teaching a method of fabricating simulated stone surfaces having relatively deep embossed depths.

Baskin discloses a method of fabricating an artificial stone-like facing, as for an attachment to a substrate, that comprises preparing a mixture of a wet, soft and uncured synthetic resin binder which is applied to a surface by means of a spray gun, troweling, brushing or rolling. The irregular surface thus prepared is then overlaid with a thin flexible film having a release layer applied to the side facing the irregular surface. This film is pressed over the irregular outer surface with rollers and the film serves as a scratch-resistant barrier which protects the product during stacking, storage and shipment. After the product is installed, the film is release stripped leaving the hardened artificial stone-like facing unitarily attached to the substrate and having the external high gloss mirror-smooth finish of the inner surface of the film. (See Baskin at column 1, lines 48-64; column 2, lines 4-13; column 3, line 63 – column 4, line 4; and column 4, lines 32-45.) Baskin's irregular surface is cured over time by the action of a polymerization catalyst. (See Baskin at column 3, lines 35-49.)

Applicants acknowledge that the pending claims are product claims. But the processes of the cited references cannot be ignored when the references are combined in a rejection under §103 because, in order for the rejection to be sustained, the combined references must make the subject matter of the claims obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. The combination of Courtoy and Baskin cannot produce the product of applicants' claims. The deep embossing created by Baskin's method of spraying, troweling, brushing or rolling would not "smooth over" in selected areas during gelling as described by Courtoy. (See Courtoy at column 2, line 6-12.) And the deep embossing created by applicants' process must smooth out during fusion/expansion in order to create the embossing in selected areas of the surface required by applicants' claims. (See specification ¶¶ [0005] and [0015].) One skilled in the art having the benefit of the Courtoy and Baskin references, even with the benefit of hindsight, would not be able to produce the product of applicants' claims. The rejection based on Courtoy in view of Baskin accordingly should be withdrawn.

Claims 34, 36, 53 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Courtoy in view of Baskin as applied to claims 31, 32, 35 and 49 above, further in view of Haemer, et al. (U.S. 4,298,646). Haemer has to do with adding a topcoat on the surface of a wear layer. The rejected claims have to do with polyurethane coatings applied to the products of the claims discussed above with reference to Courtoy and Baskin. Based on the foregoing discussion distinguishing the base claims from Courtoy and Baskin, the rejection of the dependent claims based

upon Haemer cannot be sustained because the claims are patentable over Courtoy and Baskin. Haemer is only a tertiary reference which does not overcome the deficiencies of the Courtoy and Baskin references. Accordingly, the rejection should be withdrawn.

Claims 31, 32, 34-36, 46, 48, 49, 53 and 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen, et al. (U.S. 6,555,216) in view of Courtoy, et al. Chen is cited as teaching a surface covering comprising a substrate, a foam layer, a design layer printed with a foaming inhibitor, a wear layer and a urethane topcoat layer.

Applicants respectfully disagree with the Examiner's position that Chen discloses mechanical embossing in the grout lines. As explained by applicants previously, the process of Chen, i.e., mechanical embossing after expansion and curing, and the figures of Chen, particularly figures 10 and 11, make it clear that Chen does not mechanically emboss the chemically embossed areas. The passages of Chen cited by the Examiner cannot be read to characterize the product produced by the Chen process without considering the entire description and drawings of the reference.

However, even if Chen disclosed mechanical embossing in the grout lines, the combination of Chen with Courtoy cannot teach one skilled in the art how to make the presently claimed products. One skilled in the art following the teachings of Chen would mechanically emboss the product after chemical embossing and this cannot produce applicants' claimed product. Furthermore, applicants have made it clear by amendments to claims 31 and 35, that there is no mechanical embossing on portions of the product which do not overlie the first printing ink. This further distinguishes Chen.

Even if Chen discloses an overall mechanical embossing of his product, this would not produce the areas of selective, in register, embossing claimed by applicants.

Withdrawal of the rejection based upon Chen in view of Courtoy is respectfully requested.

**Double Patenting**

Claims 31, 32, 35, 46, 48 and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of Courtoy in view of Baskin. Based upon applicants' remarks above traversing the rejection under 35 U.S.C. §103 over Courtoy in view of Baskin, applicants respectfully submit that this rejection should be withdrawn.

**Allowable Subject Matter**

Claims 33, 47, 50-52, 54 and 56-58 are objected to as being dependent upon a rejected base claim, but the Examiner has indicated they would be allowable if rewritten in independent form. Claims 33, 50 and 52 have accordingly been rewritten in

independent form and these claims and the claims dependent thereon should remain allowable.

CONCLUSION

A Notice of Allowance of all of the pending claims is respectfully requested.

Respectfully submitted,



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